

A Response to the Office Action:

A. Status of the Claims

Claims 33, 35-36, 38-39, 41, and 44-46, 48-52, and 54-69 are pending.

B. Telephone Interview With the Examiner

Applicants representative, Michael R. Krawzsenek, and Examiner Jeanine A. Goldberg conducted a telephone interview on August 28, 2006. The present invention, current rejections, and prior art references were discussed during the telephone call. No agreement was reached.

C. The Objection to Claim 41 Is Overcome

The Action objects to claim 41 under 37 C.F.R. 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. The Action states that claim 41 is directed to a backing sheet that is a release paper. The Action further states that it is unclear how claim 41 further limits claim 33 because the latter contains the limitation "a backing sheet releasably secured to the transparent polymeric sheet." Claim 41 does further limit claim 33 because the backing sheet in claim 33 could be comprised of a material other than paper. For example, the backing sheet of claim 33 could be comprised of metallic foil, plastic film, or any other material that could be releasably secured to the transparent polymeric sheet.

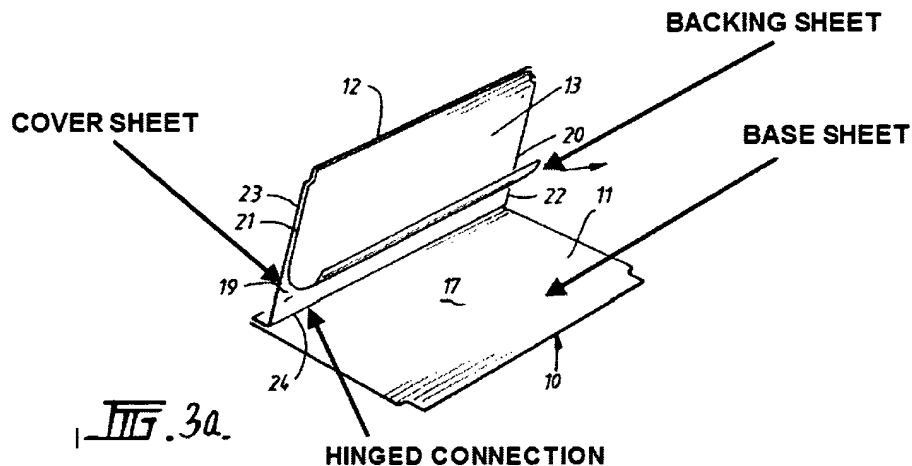
D. The Indefiniteness Rejection Is Overcome

The Action rejects claim 35 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Applicants disagree with this rejection. The present claims are definite and satisfy all of the requirements under 35 U.S.C. § 112, second paragraph.

The Action takes the position that claim 35 is indefinite in view of claim 33 and states that claim 33 “appears to require the structure contains a backing sheet releasably secured to the polymeric sheet.” The Action continues that claim 35 “appears to be directed to the structure where the backing sheet has been removed and the polymeric sheet is secured to the base sheet.” The Action concludes that the two structures described above are not coextensive, and that it is unclear if and how claim 35 can further limit claim 33.

Contrary to the statements provided in the Action, claim 35 does not require the backing sheet to be removed. The cover sheet can be irreversibly adhered to the base sheet at the hinged connection while the backing sheet is still secured to the transparent polymeric sheet. One example of such an embodiment is shown below from Fig. 3A of the application (annotations added):



The embodiment of Fig. 3A is exemplary of one embodiment within the scope of claim 35 that does not require the backing sheet to be removed from the transparent polymeric sheet. However, other embodiments are also within the scope of claim 35, and the scope of the claim is not intended to be limited to this embodiment.

Because claim 35 does not require the backing sheet to be removed from the transparent polymeric sheet, the claim is not indefinite under 35 U.S.C. § 112, second paragraph and the rejection should be withdrawn.

E. The Obviousness Rejections Are Overcome

1. Claims 33, 36, 41, 44-46, and 48-52, 55-62, 65-66, and 69 Are Not Obvious Over Evident Crimescene in View of U.S. Patent No. 6,007,104 to Draper and U.S. Patent 5,709,746 to Ballard

Claims 33, 36, 41, 44-46, 48-52, 55-62, 65-66, and 69 are rejected under 35 U.S.C. § 103(a) as being obvious over Evident Crimescene (www.evidentcrimescene.com, Latent Fingerprint Recovery, April 27, 1999) in view of U.S. Patent No. 6,007,104 to Draper. Although a reference to Ballard (U.S. Patent No. 5,709,746) is not mentioned in the explicit rejection, the Ballard reference is discussed in the explanation of the rejection. For purposes of this response, it is assumed that the rejection of claims 33, 36, 41, 44-46, 48-52, 55-62, 65-66, and 69 under 35 U.S.C. § 103(a) is made over Evident Crimescene in view of *Draper* and *Ballard*. If this is incorrect, Applicant requests clarification of the rejection and the opportunity to respond accordingly.

It is well established that there must be some motivation to combine or modify prior art references in order to support a *prima facie* case of obviousness. *See* MPEP §2143. The Federal Circuit strongly emphasized this point in *In re Sang-Su Lee*, 277 F.3d 1338 (Fed. Cir. 2002), as evidenced by the following extensive discussion on the proper framework for an obviousness rejection:

When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. *See, e.g., McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 U.S.P.Q.2D (BNA) 1001, 1008 (Fed. Cir. 2001) ("the central question is whether there is reason to combine [the] references," a question of fact drawing on the Graham factors).

"The factual inquiry whether to combine references must be thorough and searching." *Id.* It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. *See, e.g., Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2D (BNA) 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding'") (quoting *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 U.S.P.Q.2D (BNA) 1225, 1232 (Fed. Cir. 1998)); *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2D (BNA) 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."); *In re Dance*, 160 F.3d 1339, 1343, 48 U.S.P.Q.2D (BNA) 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2D (BNA) 1596, 1600 (Fed. Cir. 1988) ("teachings of references can be combined only if there is some suggestion or incentive to do so.") (emphasis in original) (quoting *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 U.S.P.Q. (BNA) 929, 933 (Fed. Cir. 1984)).

The need for specificity pervades this authority. *See, e.g., In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2D (BNA) 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); *In re Rouffet*, 149 F.3d 1350, 1359, 47 U.S.P.Q.2D (BNA) 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.")

In re Sang-Su Lee, 277 F.3d at 1342-43 (italics in original, underlining added).

In summary, the Federal Circuit provides the following framework for obviousness analyses: (1) Hindsight cannot be used when determining obviousness; (2) The teachings of prior

art references can be combined only when there is some suggestion, motivation or incentive to do so; (3) Specific findings must be made as to why one of ordinary skill in the art, with no knowledge of the claimed invention, would select the prior art references for combination in the manner claimed. Furthermore, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” MPEP §2143.01, *citing In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (emphasis in original).

In the case at issue, the Action states that Evident Crimescene teaches Latent Fingerprint Recovery Supplies, including a product supplied by BVDA sold under the “Gellifter” name. The Action provides the following observations regarding the BVDA materials: (1) BVDA Gellifters have a low-tack adhesive layer which is thick enough to lift complete prints from rough or polluted surfaces; (2) the transparent Gellifters have a clear polyester backing, while the black and white Gellifters have a backing of white rubberized linen; (3) all Gellifters are protected by a transparent polyester film.

The Action further states that Evident (*i.e.*, the BVDA Gellifter) does not specifically teach a bar code or other printed matter on a reverse surface of the base sheet with a releasably secured backing sheet. The Action provides that “Ballard teaches a self-contained fingerprint kit which comprises releasably secured sheets.” According to the Action, “it would have been *prima facie* obvious to the ordinary artisan at the time the invention was made to have modified [the] structure taught by Evident...to have used a release liner to protect the adhesive prior to use.”

The Action provides the following rationale for such modification:

Further, utilizing a backing sheet for the Evident structure would protect the adhesive and allow for the use of permanent adhesive which when contacted to the base sheet could not be tampered with. The releasable sheet, taught by Ballard would be readily removed to expose the adhesive on the Evident structures and subsequently allow the security of the samples collected.

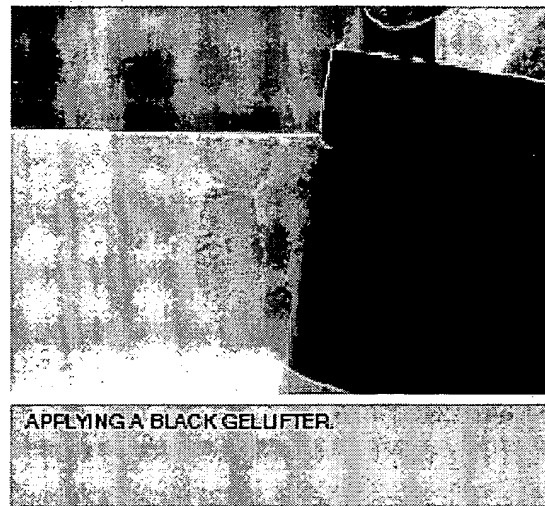
May 3, 2006 Office Action, page 5.

The Action therefore proposes the following motivation to modify the Evident structure (*i.e.*, BVDA Gellifter) to include a backing sheet: (1) to protect the adhesive; and (2) to allow for the use of permanent adhesive to prevent tampering after the cover sheet contacts the base sheet. Upon examination, neither of the reasons proposed would motivate a skilled artisan to add a backing sheet to the BVDA structure.

In addition, the Action fails to address the fact that none of the cited references teach or suggest a transparent polymeric sheet secured to the base sheet, where the transparent polymeric sheet comprises an adhesive.

a. BVDA Gellifter Discloses Adhesive on Base Sheet, Not Transparent Polymeric Sheet

As stated in the Action, the BVDA Gellifters have a “base sheet of either a polyester backing or rubberized linen” and “all gellifters are protected by a transparent polyester film.” Page 4, lines 20-22. The Action also provides “BVDA gellifters have a low-tack adhesive layer which is thick enough to lift complete prints from rough or polluted surfaces (BVDA manual, page 3).” Page 4, lines 14-16. The manual for the BVDA Gellifters also states: “These backings give the Gellifters the impressive flexibility that together with the low-tack adhesive property of the gelatin layer makes the Gellifter so easy to use.” BVDA manual, page 4. As shown below in the illustration on page 3 of the BVDA manual, the base sheet comprises the adhesive used to lift prints from the surface of interest.



In the BVDA Gellifter, the base sheet, not the transparent polyester film, comprises the adhesive. Therefore, the BVDA Gellifter does not disclose “a transparent polymeric sheet secured to the base sheet, the transparent polymeric sheet comprising an adhesive”, as required by claim 33.

As explained below, neither of the other references cited in the Action teach or suggest a transparent polymeric sheet comprising an adhesive. Even if the references did teach or suggest such a limitation, there would be no motivation to modify the BVDA Gellifter in such a manner. For example, page 3 of the manual for the BVDA Gellifter provides:

Unlike other lifting media, BVDA Gellifters have been especially developed for the lifting of fingerprints, shoeprints, dust marks and micro traces. The thick, non-aggressive, low-tack gelatin layer allows traces to be lifted from almost every surface, including porous material such as paper and cardboard. Lifted prints can be transported for photography or closer examination.

The manual therefore touts the ability of the “thick, non-aggressive, low-tack gelatin layer”, which “allows traces to be lifted from almost every surface, including porous material[.]” *Id.* If the Gellifter adhesive were placed on the transparent polymeric sheet rather than the gelatin layer, the gelatin layer would not be able to lift evidence from a porous (or any other type of) surface. In addition, it would be difficult, if not impossible, to photograph fingerprints or other evidence against a transparent background. As a result, the device would not work for its intended purpose, *i.e.*, to lift evidence from virtually any surface using a low-tack gelatin and allow the evidence to be examined or photographed. For at least these reasons, there is no motivation to modify the BVDA Gellifter by placing the adhesive on the transparent polyester sheet. MPEP § 2143.01 (V) (“If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification”). Therefore, a person of ordinary skill in the art would not be motivated to combine these references. *Id.* at 2143.01(III) (“The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination”)

Notwithstanding the fact that there is no motivation to modify the primary reference in the manner described above, neither *Ballard* nor *Draper* disclose a transparent polymeric sheet comprising an adhesive. The Action states that “Ballard teaches the release sheet is used to cover an adhesive and may be readily removed to expose the adhesive.” Page 5, line 11-12. In fact, *Ballard* teaches away from using a transparent sheet comprising an adhesive. If the adhesive of *Ballard* were placed on a transparent sheet, it would make it difficult, if not impossible, to read the indicia printed on each side of the device after it was folded. Therefore, *Ballard* does not teach or suggest a transparent sheet comprising an adhesive.

The Action cites *Draper* as teaching a form of identification material printed on the substrate. The Action does not cite *Draper* as teaching or suggesting a transparent sheet comprising an adhesive, and in fact, the reference does not teach such or suggest such a structure. *Draper* does teach a securement sheet 60 that secures a blood application sheet to the substrate. However, *Draper* does not disclose or suggest that the securement sheet 60 be transparent.

Therefore, the cited references do not teach or suggest all of the claim limitations, and *prima facie* obviousness has not been established. MPEP §2143.03 citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). The obviousness rejection is improper, and therefore should be withdrawn.

b. Backing Sheet Not Needed to Protect Adhesive

Furthermore, the obviousness rejection is improper because there is no suggestion or motivation to include a backing sheet with the BVDA reference.

As noted in the Action, the “transparent Gellifters have a clear polyester backing, [and] the black and white have a backing of white rubberized linen.” Page 4, lines 16-17. The Action further provides that “all Gellifters are protected by a transparent polyester film (page 2 of 6

from Gellifter Manual).” Page 4, lines 20-22. The adhesive in the Gellifter is therefore already protected by the polyester or linen backing on one side and the polyester film on the other side. Consequently, there is no motivation to modify the design by adding a backing sheet in order to protect the adhesive. The addition of such a sheet would add to the cost and complexity of the design and serve no useful purpose. Such a modification would not have been desirable, and therefore would not have been obvious. *See In re Beattie*, 974 F.2d 1309, 1311 (Fed. Cir. 1992) (“Stated another way, the prior art as a whole must ‘suggest the desirability’ of the combination) (internal quotation omitted); *Winner Int’l Royalty Corp. v. Wang*, 202 F.3d 1340 (Fed. Cir. 2000) (“Trade-offs often concern what is feasible, not what is, on balance, desirable. Motivation to combine requires the latter.”); *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984) (“The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.”)

Adding cost and complexity to the BVDA device without providing an additional benefit is not desirable; therefore, it is not obvious to modify the BVDA device by adding a backing sheet.

c. Permanent Adhesive Would Render BVDA Gellifter Inoperable for Intended Purpose

The second proposed motivation for adding a backing sheet to the BVDA Gellifter also does not withstand reasoned analysis. According to the Action, the addition of a backing sheet would allow for the use of permanent adhesive to prevent tampering. However, the use of a permanent adhesive would render the BVDA Gellifter completely inoperable for its intended purpose of lifting fingerprints, footprints, and other prints from surfaces. If the Gellifter adhesive were permanent, it would permanently stick to the surface from a which a print was being lifted. This would not allow the user to lift a copy of the print from the surface to use for

forensic analysis. Furthermore, attaching the Gellifter permanently to the surface would cover up the print and prevent further analysis of the surface.

Not only is removal from the surface a necessary feature, the Gellifter brochure points out the ability of the device to be applied to and removed from a surface multiple times. The manual also emphasizes the ease with which the device can be removed from a surface. For example, page 2 of the manual provides the following statements:

Risk-free lifting

Gellifters make it possible to lift the same print multiple times without the risk of destroying it. Also, there is minimal or no risk of damaging the surface of the exhibit.

Easy to use

The flexibility of the Gellifter makes it easy to apply on any surface. The low-tack adhesive makes it easy to remove.

As shown in these statements, a critical feature of the BVDA Gellifter is the ability to apply it to a surface and then remove it. In fact, the name of the device incorporates the word “lift” because the device is intended to do just that: lift an image from a surface to allow forensic analysis of the image. The brochure also emphasizes the benefits of having a low-tack, rather than a permanent, adhesive. These benefits include the ability to: (1) lift the same print multiple times without destroying it; (2) minimize the risk of damage to the surface; and (3) easily remove the Gellifter from the surface.

Therefore, if the Gellifter were modified to include a permanent adhesive rather than the current low-tack adhesive, the Gellifter would not be satisfactory for its intended purpose. “If

[the] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” MPEP §2143.01 *citing In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984); *see also Tec Air, Inc. v. Denso Mfg. Michigan Inc.*, 192 F.3d 1353 (Fed. Cir. 1999) (“[i]f when combined the references “would produce a seemingly inoperative device,” then they teach away from the combination”) (citation omitted). Because utilizing a permanent adhesive in the Gellifter would render it inoperable for its intended purpose, there is no motivation to make such a modification.

d. Summary

For at least the reasons detailed above, it would not have been obvious to modify the BVDA Gellifter to include either: (1) a transparent polymeric sheet secured to the base sheet, with the transparent polymeric sheet comprising an adhesive; or (2) a backing sheet releasably secured to a transparent polymeric sheet. Therefore, independent claims 33 and 55 are not unpatentable over Evident Crimescene (*i.e.*, BVDA Gellifter) in view of *Draper* and *Ballard* and the rejection should be withdrawn.

Dependent claims 36, 41, 44-46, and 48-52 depend from claim 33 and are therefore also patentable for at least the reasons explained above. Dependent claims 56-62, 65-66, and 69 depend from claim 55 and are therefore also patentable for at least the reasons explained above. Furthermore, the dependent claims contain additional limitations that render them patentable over the cited references. For example, claim 51 requires the storage structure to comprise a biological sample that is a bodily fluid. It would not have been obvious to one skilled in the art to modify the BVDA Gellifter to comprise a bodily fluid. Such a modification would render the device unsatisfactory for its intended purpose, *i.e.* to lift fingerprints or other images from a surface for forensic analysis. Because the modification would render the device unsatisfactory for its intended purpose, the modification would not have been obvious. *See* MPEP §2143.01.

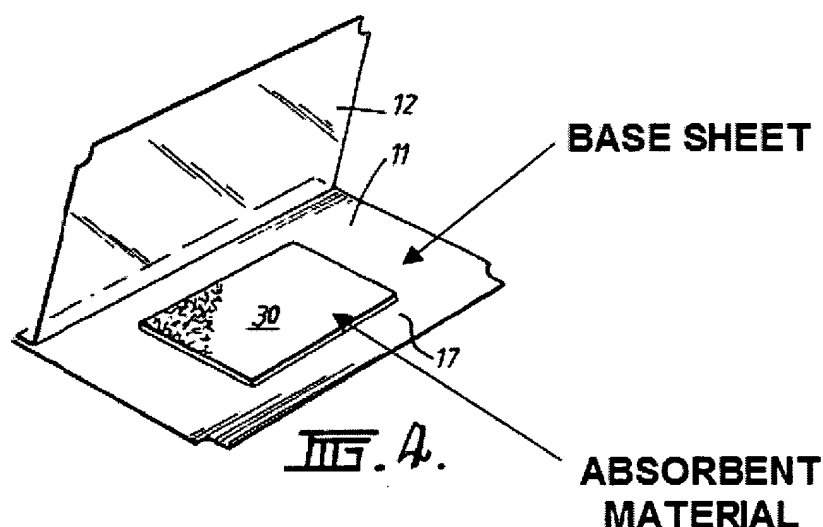
2. Claim 35 Is Not Obvious Over Evident Crimescene in View of U.S. Patent No. 6,007,104 to Draper and U.S. Patent 5,709,746 to Ballard

Claim 33 is patentable for at least the reasons set forth above. Because claim 35 depends from claim 33, it is also patentable. As explained above in Section D, claim 35 does not require the backing sheet to be removed. The cover sheet can be irreversibly adhered to the base sheet at the hinged connection while the backing sheet is still secured to the transparent polymeric sheet

3. Independent Claim 55 Is Further Patentable

Claim 55 is patentable for at least the reasons provided above in Section E.1. Applicant also notes that this claim recites “the base sheet comprising an absorbent material that is secured to a portion of a front surface of the base sheet[.]”

This feature is illustrated in a non-limiting aspect at FIG. 4 of Applicant’s specification, shown below (annotations added):



The specification also describes the absorbent material in a non-limiting aspect:

An absorbent material may be secured on the front surface of said base sheet. This makes collection of body fluids easier as a quantity of these may be absorbed by the absorbent layer. Typically the absorbent layer is blotting paper.

Applicant's Specification, page 10, lines 4-8.

There is no motivation to modify the primary reference (*i.e.*, the BVDA Gellifter) to include an absorbent material. If an absorbent material was included on the BVDA Gellifter, it would be more difficult to obtain or examine any print evidence. Therefore, the addition of an absorbent material to the BVDA device would serve no benefit and would render the device unsatisfactory for its intended purpose. Consequently, such a modification would not have been obvious, and claim 55 is patentable for this reason as well. *See* MPEP §2143.01.

F. Conclusion

Applicants believe that the present document is a full and complete response to the May 3, 2006 Office Action. The present case is in condition for allowance, and such favorable action is requested.